

REMARKS

Claims 1 through 6 remain in the application, with claim 1 in independent form. No amendment to the claims has been made in the present Response.

Elections/Restrictions

The Applicants affirm the election of claims 1 through 6. While claims 11 through 34 are presently withdrawn as directed to non-elected species that were subject to a species restriction, the Applicants respectfully request a rejoinder of claims 11 through 34 upon the allowance of a generic linking claim.

In addition, the Applicants respectfully direct the Examiner to the instant Office Action, specifically to the page entitled “Office Action Summary”. Regarding the disposition of the claims, a typographical error has been made. Under section 4), the Applicants believe that “Claim(s) 1-20 is/are pending in the application.” should read “Claim(s) 1-34 is/are pending in the application.” Further, under section 4a), the Applicants believe that “Of the above claim(s) 7-20 is/are withdrawn from consideration.” should read “Of the above claim(s) 7-34 is/are withdrawn from consideration.” In sum, the Applicants believe that claims 21-34 were inadvertently left off of the Office Action Summary. The same error is also present on page 3 of the instant Office Action.

Claim Rejections - 35 USC §112

Claims 1 through 6 stand rejected under 35 U.S.C. §112, first paragraph. The instant specification is objected to under 35 U.S.C. §112, first paragraph, because, according to the

Examiner, the Applicants have failed “to incorporate a foreign test standard in the specification”. The Examiner directs the Applicants to a foreign test standard in the instant specification in paragraphs [0033] and [0035], namely JIS K 6300 and JIS K 6249, respectively. The Applicants respectfully assert that the foreign test standards are not incorporated by reference, but instead, the foreign tests standards are merely referred to as *possible* tests to be followed by one skilled in the art in order to practice the present invention. Accordingly, the 35 U.S.C. §112, first paragraph objection should be withdrawn.

Further, if only for arguments sake, the Applicants also respectfully traverse this rejection and submit that the instant specification satisfies 35 U.S.C. §112, first paragraph. Specifically the Applicants respectfully assert that the Examiner has failed to adequately provide a reason why the instant specification would not comply with the enablement requirement. The Examiner has the initial burden of producing reasons that substantiate a rejection based on lack of enablement. See *In re Strahilevitz*, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (C.C.P.A. 1982); *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (C.C.P.A. 1971); and MPEP 2163.04. The Examiner has referenced foreign test standards; however, the test for compliance with the enablement requirement, as found in the first paragraph of 35 U.S.C. §112, is whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. See *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988); *In re Scarbrough*, 500 F.2d 560, 566, 182 USPQ 298, 303 (C.C.P.A. 1974); and MPEP 2164.01

The Applicants direct the Examiner to the instant specification at paragraph [0033], where the present application first introduces a foreign test standard, specifically JIS (Japanese Industrial Standard) K 6300, which relates to determining vulcanizing times. “The curing speeds of these curable silicone compositions **may, for example,** be compared based on their 90% vulcanizing times $\{t_c(90)\}$ measured under the same temperature conditions (for example, 130° C., 150° C.) in vulcanizing tests performed using an oscillating vulcanizing tester, as specified by JIS K 6300.” (emphasis added). In other words, for purposes of the present invention, vulcanizing times of the compositions **may be determined according to specifications in JIS K 6300**. JIS K 6300 is also described in paragraphs [0051], [0078], [0081], and [0085] of the instant specification. As described above, JIS K 6300 is not incorporated by reference but is merely one referenced standard that could be followed by one skilled in the art, if so desired. However, other equally suitable standards known in the art for determining vulcanizing times of the compositions could also be followed.

The Applicants also direct the Examiner to the instant specification at paragraph [0035], where the present application first introduces JIS K 6249, which relates to determining plasticity numbers. “The plasticity numbers of theses (sic) clay-like curable compositions, as specified by JIS K 6249 are not limited, and may either be the same or different.” Further, “[t]he plasticity numbers are the values when a load of $49 \pm 0.05\text{N}$ is applied for 3 minutes to a specimen {a cylindrical object (diameter: 16 mm, height: 10 mm) with a volume of $2 \pm 0.02 \text{ cm}^3$ } by means of a parallel plate plastimeter (William’s

Plastimeter) **according to the specifications in JIS K 6249.**” (emphasis added). In other words, for purposes of the present invention, plasticity numbers of the compositions **may** be determined according to specifications in JIS K 6249, specifically by following the method quoted above. JIS K 6249 is also described in paragraphs [0056] and [0078], and is claimed in claim 2 of the present application. While not noted by the Examiner, The Applicants further direct the Examiner to paragraph [0078] of the instant specification, where JIS K 6253 is first introduced in the present application in order to determine hardness of a cured silicone substance. Yet again, as similarly described above, JIS K 6253 is not incorporated by reference but is merely one referenced standard that could be followed by one skilled in the art, if so desired.

Further, the Applicants respectfully assert that those of ordinary skill in the silicone art are well aware of various standards, tests, specifications, and methods related to determining vulcanizing times of materials, such as by following JIS K 6300; plasticity numbers of materials, such as by following JIS K 6249; and hardness of materials, such as by following JIS K 6253; as well as other standards, tests, specifications, and methods for determining other physical properties of materials. Therefore, undue experimentation for making and using the present invention **would not be required**, as vulcanizing times, plasticity numbers, and hardness of the components can readily be determined by **directly following the respective specifications as taught and outlined by JIS K 6300, JIS K 6249, and JIS K 6253**. Further, the Applicants note that JIS K 6300, JIS K 6249, and JIS K 6253 have been previously disclosed in previous U.S. patent applications, as are other

standards, tests, specifications, and methods known to those of ordinary skill in the silicone art regarding physical properties of materials, **without** the aforementioned patents providing any additional information pertaining to specifics of these standards, tests, specifications, and methods themselves. See for example, U.S. Patent Application Nos. 6,033,597 and 4,849,021 employing JIS K 6300; U.S. Patent Application Nos. 7,160,123 and 6,333,364 employing JIS K 6249; and U.S. Patent Application Nos. 6,097,132 and 6,363,229 employing JIS K 6253. Accordingly, in view of the foregoing, the 35 U.S.C. §112, first paragraph objection should be withdrawn.

Claim Rejections - 35 USC §102

Claims 1 through 6 stand rejected under 35 U.S.C. §102(b) as being anticipated by Japanese Publication No. 200119933 to Isshiki (using U.S. Patent No. 6,379,792 to Isshiki as a translation). The Applicants respectfully traverse this rejection on the basis that Isshiki fails to teach each and every element of claim 1, as required to properly establish anticipation under 35 U.S.C. §102(b). In addition, relative to any obviousness concerns, Isshiki fails to teach or suggest all of the limitations of the present invention as are claimed in claim 1.

To summarize, claim 1 encompasses a silicone-based adhesive sheet. The silicone-based adhesive sheet comprises a **first layer** of a curable silicone composition on **one side** of the sheet, and a **second layer** of a **slower curing** silicone composition than the first layer on the **other side** of the sheet (emphasis added). In other words, the silicone-based sheet comprises **two layers**, with each of the layers formed from different silicone compositions having **different curing speeds relative to each other**.

As the Examiner is well aware, to establish anticipation under 35 U.S.C. §102, the reference must teach each and every element of that claim. See MPEP §2131. In addition, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” See *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970).

Isshiki discloses a silicone adhesive sheet. A silicone rubber member/sheet or an organic resin sheet can serve as an interior/support of the silicone adhesive sheet and the silicone adhesive sheet can have “sides” that comprise a crosslinkable silicone composition, i.e., the sides of the silicone adhesive sheet can be formed from a crosslinked product of the crosslinkable silicone composition.

In the instant Office Action, the Examiner appropriately recognizes that Isshiki teaches that there are **no particular restrictions on the degree of crosslinking** of the crosslinked product. Specifically, Isshiki fails to disclose, teach, or even suggest a silicone adhesive sheet having **two layers formed from silicone compositions having different curing speeds** as claimed in the present application. Alternatively, Isshiki teaches that the silicone adhesive sheet can be formed from **just the crosslinked product** of the crosslinkable silicone composition. In other words, Isshiki teaches that the silicone adhesive sheet can comprise just one layer, which further detracts from any possible argument that Isshiki teaches or suggests the present invention as claimed. In view of the foregoing, the Applicants respectfully submit that claim 1 is novel over the prior art, and therefore, the §102(b) rejection is overcome.

The Examiner identifies that Isshiki teaches use of a hydrosilation inhibitor. *However*, even with this teaching of the hydrosilation inhibitor, there is still no disclosure, no teaching, or even a suggestion of different curing speeds. Instead, Isshiki **only discloses a single curing rate** of its crosslinkable silicone composition. For example, see column 13, lines 16-18 of Isshiki where “[i]t is preferable for the above composition to contain a hydrosilylation reaction inhibitor in order to adjust the hydrosilylation reaction **rate**.” (emphasis added). In other words, Isshiki only teaches reaction rate in **the singular** *rather than* in **the plural**, as taught and claimed in the present invention. For example, see paragraph [0051] of the instant specification where “...compositions with different curing **speeds** can be prepared.” (emphasis added).

Yet further, the primary focus of Isshiki is a silatrane derivative (See, for example, column 2, line 49+ through column 8). Isshiki also focuses on methods of manufacturing the silatrane derivative (See, for example, column 9 through column 11, line 22). See also the Working Examples and Figures of Isshiki, which only illustrate and teach **a single layer** of the crosslinked product. In view of the foregoing, although not necessary in view of the current rejections, it is clear that no 35 U.S.C. §103 rejection would be proper.

The Applicants respectfully submit that claim 1 is both novel and non-obvious, in view of the disclosure, teachings, and suggestions of the prior art such that claim 1, as well as the claims that depend therefrom, are in condition for allowance. If any additional fees are

necessary to respond to the outstanding Office Action, you are hereby authorized to charge such fees to Deposit Account No. 08-2789 in the name of Howard & Howard.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS

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Date

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